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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,791	10/29/2003	Reinhard Deutsch	41653-197865	6085
26694	7590	06/30/2004	EXAMINER	
VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP				PURVIS, SUE A
P.O. BOX 34385				ART UNIT
WASHINGTON, DC 20043-9998				PAPER NUMBER
				1734

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/694,791	DEUTSCH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sue A. Purvis	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 23-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 23-30 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/29/03 & 3/25/04.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_.

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## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 28 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claim 28 requires that the 'pickup mechanism **caused** by the law of motion...to roll tangentially...' Please clarify this language, elaborating what the applicant is trying to claim and point out if there is any supporting language in the specification for this claim as the examiner was unable to find any.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 27-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear upon reading claim 27 what the applicant is trying to claim. In particular, claim 27 states 'generating according to a previously determined law of motion and described about an axis lying parallel to a reference plane of the pickup station'. This

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phrase appears not to add any additional structural limitations to the claim and it is unclear whether the applicant meant to it to add structural features or not. Clarification is required. The rejection below is based on the first portion of claim 27 which requires a pickup and application device with a pickup assembly capable of movement between the pickup station and a release position.

***Claim Interpretation***

5. During patent examination, claims are given their broadest reasonable interpretation consistent with the specification. It is proper to use the specification to interpret what the applicant meant by a word or phrase recited in the claim. However, it is not proper to read limitations appearing in the specification into the claim when these limitations are not recited in the claim. See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); *Intervet America Inc. v. Kee-Vet Lab. Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474,1476 (Fed. Cir. 1989).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Kronseder (US Patent No. 5,024,348).

Kronseder discloses a magazine assembly in a labeling machine where a means by which labels are procured in a stack or magazine. The supply magazine is replaceable.

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Transfer plates (47) is the universal pick up device which picks up the label from the replaceable magazines.

Regarding claim interpretation, applicant's use of the alternative language in the claim results in a single feed which is interchangeable either with itself or with a second type of feed. Since claims are given their broadest reasonable interpretation consistent with the specification. Figures 1 and 2 of applicant's specification shows the apparatus having two different feeds being capable of being mounted to the machine, but the claim requires either a first feed means "or" a second feed means. It is proper to use the specification to interpret what the applicant meant by a word or phrase recited in the claim. However, it is not proper to read limitations appearing in the specification into the claim when these limitations are not recited in the claim. See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); *Intervet America Inc. v. Kee-Vet Lab. Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474,1476 (Fed. Cir. 1989).

Regarding claim 25, the feed means in Kronseder includes labels (48) fed from a magazine (3).

8. Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Vijuk (US Patent No. 4,812,195).

Vijuk discloses that an important aspect with respect to the folding station (33) the sheets are fed and folded is that sheet station (26) is separate. Therefore, it is possible to substitute the web accumulator (28) and web severing means (31) with a stack sheet feeder having a stack of pre-cut sheets therein and feeding them to the folder. (Col. 7, lines 16-30.) The folding station (33) is considered equivalent to applicant's pickup and application station because it folds the sheet and effectively applies one side of the sheet to another side.

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9. Claims 23-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Bright (EP 0 370 633 A1).

Bright discloses a unit for applying labels to packets with first means by which the labels are procured as single items ordered in a stack (Figure 2) or a second means by which to feed slips obtainable as cuts made from a continuous strip (Figures and 3), and a universal pickup and application device (19) installed permanently in the machine such as will take up the slips with equal facility from either the first or the second feed means.

Regarding claim 24, the first and second feed means are mutually interchangeable.

Regarding claim 25, the first feed means comprise a magazine (75) containing a plurality of labels ordered in a stack aligned on a relative axis substantially perpendicular to the pickup station.

Regarding claim 26, the second feed means comprise a means which respectively decoil, feed and cut a continuous strip to index the strip.

Regarding claim 27, the pickup and application device (19) moves between the pickup station and a release position.

Regarding claim 28, the pickup assembly (19) comprises a pickup mechanism (it is a vacuum drum).

#### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bright in view of Focke et al. (US Patent No. 5,203,953) and Voltmer et al. (US Patent No. 4,605,459).

The vacuum drum (19) in Bright includes suction holes which are a functionally equivalent alternative expedient of the applicant's suction cup. Focke shows the same pick up member for both magazine and strip feed means. The pickup member includes suction bores. Voltmer discloses a suction cup (28) being used as a pick up means.

It would have been obvious to one having ordinary skill in the art at the time the invention was made that either suction bores or a suction cup can be used to pick up the label from the feed magazine or the cut feed strip, because both methods are known and used in the art.

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rick Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sue A. Purvis  
Primary Examiner  
Art Unit 1734

SP  
June 25, 2004